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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,431	10/14/2003	Dale W. Malik	190250-1590	7278
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EXAMINER				
CHANG, JUNGWON				
ART UNIT		PAPER NUMBER		
2454				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,431

Applicant(s)

MALIK ET AL.

Examiner

JUNGWON CHANG

Art Unit

2454

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 9/2/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to Remarks filed on 11/14/08. Claim 21 has been canceled. Claims 1-20 and 22 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al, (US 2004/0128356), hereinafter Bernstein, in view of Beyda (US 2003/0229670).
4. As to claims 1, 9 and 10, Bernstein discloses the invention as claimed, including method comprising the steps of:

determining an Internet presence of a contact identified in an email message (page 2, 0016-0017, "presence detection by sending...email invitation"; page 1, 0007, "particular user's presence online...presence detection"); and

initiating, by the instant messaging client (instant messaging application) an instant messaging (IM) chat session with the contact in response to determining that the contact is present (page 1, 0007; page 4, 0064, "each recipient is sent an instant

message invitation email message").

5. Although Bernstein discloses determining an internet presence of a contact, Bernstein does not specifically disclose the presence of the contact is determined by an instant messaging client. Beyda discloses the presence of the contact is determined by an instant messaging client (120, fig. 6; page 2, 0022, "user's online presence may still be detected or monitored by an instant messaging system"; 0029, "instant messaging server, service or system and thereby capable of detecting or monitoring the online presence"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Beyda because Beyda's teaching would allow a user to be notified of the presence of the intended recipient, as taught by Beyda (page 1, 0004-0005).

6. As to claims 2-8, Bernstein discloses, wherein the step of initiating the IM chat session comprises the steps of: generating an IM chat window; obtaining information from the email message; and displaying the obtained information in the generated IM chat window (page 2, 0023, "IM area"; page 5, 0093-0100, "display to the user").

7. As to claims 11-13, they are rejected for the same reasons set forth in claims 2-8 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

8. As to claim 14, it is rejected for the same reasons set forth in claim 1 above. In

addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

9. As to claims 15-19 and 22, they are rejected for the same reasons set forth in claims 1-8 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al, (US 2004/0128356), hereinafter Bernstein, in view of Beyda (US 2003/0229670), further in view of Dalal et al, (US 2002/0065894), hereinafter Dalal.

11. Bernstein discloses displaying the obtained information in the generated IM chat window (page 2, 0023, "IM area"; page 5, 0093-0100, "display to the user"). However, Bernstein does not specifically disclose providing the body of the email message as an IM chat message. Dalal discloses providing the body of the email message as an IM chat message (page 3, 0024, "the body of the email reply becomes the text content of the instant messaging"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Dalal because Dalal's teaching would reduce the time to generate an instant message which has correlation information with the email message, as taught by Dalal (page 3, 0024).

12. Applicant's arguments filed on 11/14/08 have been fully considered but they are

not persuasive.

(1) Bernstein and Beyda either alone or in combination, do not disclose or suggest determining "an internet presence of a contact identified in an email message" as recited in claim 1.

The examiner respectfully disagrees. The examiner notes that present application or claims do not clearly define how the instant messaging client determines the internet presence of a contact identified in an email message". The examiner interprets the limitation broadly. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004).

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein, in view of Beyda. Bernstein discloses initiation of an Instant Messaging session between two or more parties through the use of email integration (page 1, 0001, 0013; page 6, 0118; page 7, 0140-0142). The sender can indicate that presence detection is allowed to certain individuals (recipients) simply by sending those individuals an email/IM invitation (page 6, 00122-0123; page 7, 0132). The sender who has given "presence detection" permission initiates Instant Messaging request in email and upon receipt of the email invitation, the recipient can detect the online presence of the sender (page 2, 0016-0017; page 6, 00122-0123; page 7, 0132). In addition, Beyda is relied upon only to teach presence of the contact is determined by an instant messaging client (120, fig. 6; page 2, 0022, "user's online presence may still be detected or monitored by an instant messaging system"; 0029, "instant messaging server, service or system and

thereby capable of detecting or monitoring the online presence”).

(2) Claims 9, 10 and 14 are not disclosed or suggested by the cited references for the same reasons discussed above in connection with independent claim 1.

The examiner respectfully disagrees. For the reasons set forth in section (1) above, Claims 9, 10 and 14 are rejected under U.S.C. 103(a) as being unpatentable over Bernstein, in view of Beyda.

(3) Bernstein does not disclose or suggest “obtaining information from the email message” and “displaying the obtained information in the generated IM chat window” as recited by claim 2.

The examiner respectfully disagrees. The examiner notes that present application or claims do not clearly define what information is obtained. The examiner interprets the limitation broadly. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004).

Bernstein discloses an email with an integrated Instant message (page 1, 0001; page 6, 0118). Bernstein discloses obtaining information (i.e., email message, email address) from the email message (page 6, 0123-page 7, 0124, “a user sends an IM-enriched email they may have to type in their email address...the email address must be included with the IM”). Bernstein discloses displaying the obtained information (received email body) in the generated IM chat window (page 2, 0020, “upon receiving such an email, the recipient will be able to read the email body as they always have, and below the email body will be an area in which to participate in an Instant Messaging

conversation with the sender").

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUNGWON CHANG whose telephone number is (571)272-3960. The examiner can normally be reached on M-F 6:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 2454

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JUNGWON CHANG/
Primary Examiner, Art Unit 2454
March 1, 2009